

Remarks

Claims 1-20 are pending in the application. Claims 15-20 are withdrawn from consideration. No claims have been amended.

The Abstract has been amended to overcome the objection to the Specification.

Based on the present Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claims 1, 2 and 4-7 stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 3,603,058 to Schubert.

Reconsideration of the rejection of claim 1 in view of Schubert is respectfully requested. Claim 1 recites "compensating means between said transfer device and said guide means."

As teaching this feature of claim 1, the Action generally cites Figs. 2-7 of Schubert. However, Schubert does not disclose a compensating means. In Schubert, the top ram/plunger 46 is guided by cam surface 47. Spring 52 maintains the ram 46 against the cam surface 47. Similarly, the bottom plunger 3 is guided by roller follower 29 tracking the face of cam surface 4. Spring 31 maintains the plunger 3 against the cam surface 4. The cam surfaces 4, 41 are stationary and unyielding and do not "compensate" for anything. In other words, the plungers follow the same path and extend the same distance for every cycle.

In the present invention, the compensating means enables a longer than normal or longer than anticipated movement of the transfer device 17 when the quantity of filter material in the tube is less than required, and also enables the transfer device 17 to perform a shorter than normal or shorter than anticipated movement when the quantity of filter material in the tube exceeds the optimum quantity. Generally, the compensating means is intended to eliminate excess spaces in the filter material formed when the tobacco material is less than usual.

In addition to failing to disclose a compensating means, Schubert neither appreciates nor recognizes an advantage of such a compensating means. According to Schubert, the device described therein results in "an accurately determined amount of granular material." (col. 6, lines

53-54). Schubert also states "each of a succession of filter tips contains the same quantity of granular filter material and...the space occupied by such granular material in each of a series of successively produced filter tips is the same." (vol. 2, lines 12-16). Thus, Schubert does not account for or consider that a less than optimum amount of tobacco material could be delivered and thus, cannot teach a "compensating means."

Furthermore, claim 1 invokes 35 U.S.C. §112, first paragraph, by reciting "compensating means." See MPEP § 2181. In such instances, the Federal Circuit has stated "the U.S. Patent and Trademark Office may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability opinion." In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). The Action must not only show that the prior art structure performs an identical function as that specified in the claim (i.e., a "compensating" means), but "under Donaldson, an Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." (emphasis added) MPEP § 2182. The Action has failed to show how the structure in Schubert is identical or equivalent to the corresponding structure described in the present specification, as required by the Federal Circuit and the MPEP.

It is respectfully submitted that the structure in Schubert is not identical to that of the present invention. The compensating means of the present invention includes a spring 28 that can urge the plunger 17 to a level below which is normal or expected as compared to a predetermined distance or level. Particularly, spring 28 bears against collar 31 to urge the plunger 17 downward into the tube (page 19, line 12 – page 20, line 4). Other elastic compensating means, for example foam, can also be used. Although Schubert teaches the use of a spring, the springs of Schubert are used to urge the plunger away from the tube. The movement of the plunger in Schubert is guided by unyielding cam faces and roller followers. The cam arrangement is not a "compensating means", and more particularly, the structure of Schubert is not identical or equivalent to that described in the specification.

Appl. No. 10/057,929
Amendment dated September 29, 2003
Reply to Office Action of April 29, 2003

Accordingly, claim 1 distinguishes over Schubert and is allowable over Schubert.

Claims 2 and 4-7 depend from claim 1 and are allowable as depending from an allowable claim.


Claims 3, 8, 9 and 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,603,058 to Schubert. Claims 3, 8, 9 and 12-14 depend from claim 1 and are allowable as depending from an allowable claim.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

A Notice of Allowance with claims 1-20 is respectfully requested.

Respectfully submitted,

Date: 09/29/03


Chad C. Anderson
Registration No. 44,505
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4800
Telefax: (202) 344-8300